REMARKS

Claims 1-33 were pending in the present application. Claims 2-9, 13-18, and 28-33 stand rejected under 35 U.S.C. § 112 ¶1 as failing to comply with the enablement requirement in regards to the densities and rebound rates disclosed in the application. Claims 2-9, 13-18, and 28-33 stand rejected under 35 U.S.C. § 112 ¶2 as failing to particularly point out and distinctly claim the subject matter regarded as the invention. Claims 1-33 stand rejected under 35 U.S.C. § 102 as being anticipated by Hardt (U.S. Pat. Pub. No. 2002/0092203). Claims 4-5, 10, 12-14, and 30-31 are cancelled by the present amendments without prejudice. We will address the Examiner's rejections out of order for sake of brevity. "Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims." MPEP 2164.04.

Rejection of claims 2-9, 13-18, and 28-33 under 35 U.S.C. § 112 ¶2

The Applicants acknowledge the Office's rejection of dependent claims 4-5, 13-14, and 30-31 for the reasons discussed in the Examiner's remarks. The Applicants have cancelled the rejected claims, and amended the specification through the substitute specification submitted herewith to stike potentially confusing matter relating to this issue.

The Applicants respectfully dispute the Offices's rejection of various dependent claims, e.g., claims 2-3 and 32-33, for reasons relating to the phrase "rebound rate." We note that the Applicants are permitted to be their own lexicographers and that "the meaning of a particular claim term may be defined by implication, that is, according to the usage of the term in context in the specification." MPEP § 2111.01(III) We respectfully submit that the Applicants have particularly pointed out and distinctly claimed the subject matter regarded as the invention, and direct the Examiner's attention to the following excerpt from paragraph 0020 of the specification (as filed) as it relates to the term "rebound rate":

> In the first embodiment, the rebound rate of first pad 40 is greater than the rebound rate of second pad 42. Thus, as for use with a runner, second pad 42 absorbs a greater amount of energy from the impact of a foot coming downwardly thereon in comparison to first pad 40, which returns a relatively greater amount of the impact energy to the foot to help it spring upward and forward. In more common terms, second pad 42 tends to absorb or deaden the impact from the generally downward movement of the foot while first pad 40 relatively bounces back or returns the generally downward impact energy to create an upward lift.

See also paragraph 0005 of the specification ("with a high energy return rate, or rebound rate, in..."). The Applicants have clearly disclosed that the term "rebound rate" is a material property that describes the return of impact energy during a step. The Applicants' choice to describe this property using a fraction would clearly be understood by a person of ordinary skill in the art as reflecting the energy fraction returned versus the energy fraction absorbed during a step. Furthermore, the Applicants could appropriately choose to describe this property as a rate, in that walking or running involves repetitive steps, and the fraction returned may appropriately be described as either a fraction returned during single step or a fraction returned during each step, the fraction returned during each step constituting an event rate rather than a time rate. Thus, the phrase "rebound rate" is neither vague nor indefinite.

We further note that the Office is bound to give claims their "broadest reasonable interpretation *consistent with the specification*," MPEP § 2111 (emphasis added). Nevertheless, to address the Examiner's concern that "a rebound rate usually represents the amount of time it takes for a material to rebound to a certain percentage of its orginal shape and size," we have amended the claims and the specification through the substitute specification submitted herewith to substitute the term "rebound property" or "rebound" for the term "rebound rate" and the term "rebound properties" for the term "rebound rates." We respectfully submit that these amendments are consistent with the original disclosure and include no new matter.

Rejection of claims 2-9, 13-18, and 28-33 under 35 U.S.C. § 112 ¶1

In view of the above, the Applicants respectfully dispute the Examiner's rejection of the various dependent claims, e.g., claims 2-3 and 32-33, as referencing subject matter that is non-enabling for reasons relating to the phrase "rebound rate." "A specification disclosure which contains a teaching of the manner and process of making and using an invention *in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented* must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support." MPEP § 2164.04 (emphasis added). The Applicants understand the Examiner's rejection to be based upon a construction of the term "rebound rate" as requiring a time rate of recovery. We respectfully submit that the aforesaid remarks demonstrate how such a construction is inappropriate under MPEP §§ 2111 and 2111.01(III), and that the Office has not advanced any reason to doubt the objective truth of the disclosure in view of the claims. We further note that the Office has not suggested that a person having ordinary skill in the art would be unable to determine the energy fraction returned during a step. In passing, the Applicants note that elastomer rebound tests are well known in the art. See, e.g., ASTM D2632 92 (Vertical Rebound).

Rejection of claims 1-33 under 35 U.S.C. §102

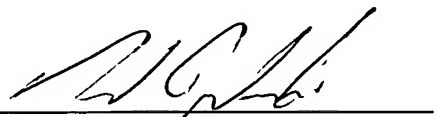
Independent claims 1 and 17 have been amended to more particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. We respectfully submit that the Hardt reference (U.S. Pat. Pub. No. 2002/0092203) does not show an insole comprising: an insole material; a first elastomeric pad attached to the insole material and positioned to contact a metatarsus section of a foot; and a second elastomeric pad attached to the

insole material and positioned to contact a heel portion of a foot; the first and second pads being horizontally distinct from one another; and the first and second pads each pad having a rebound property, the rebound of the first pad differing from the rebound of the second pad. While independent claim 17 has been amended in a manner similar to independent claim 1, we additionally note that the Hardt reference neither discloses nor suggests that any component of the disclosed insole may instead be emplaced within the sole of a shoe. We respectfully request that the Office treat said independent claims separately in future proceedings.

Conclusion

In view of the foregoing remarks, the Applicants respectfully submit that the outstanding rejections should be withdrawn. The Applicants further submit that the claims are allowable over the art of record and pray for a prompt allowance. We hereby authorize the Commissioner under 37 C.F.R. § 1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension. The Commissioner is authorized to charge any additional fees required or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted,



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